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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				HEINCER, LIAM J
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1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Response to Amendment

The proposed amendment will not be entered as they would require new search and consideration. Although the claim limitations added to the independent claims have been previously presented, the combination of the limitations has not been previously presented. Additionally, the limitations were not previously presented in terms of the method of claim 7. For these reasons, new consideration would be required by the proposed amendment.

Response to Arguments

Applicant's arguments filed January 30, 2009 have been fully considered but they are not persuasive, because:

- A) Applicants argument that Belt et al. does not exemplify the use of natural rubber is not persuasive. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See MPEP § 2123. Even though Belt et al. may disclose more synthetic rubbers than natural rubbers, natural rubbers are explicitly taught by the reference (2:15-19).
- B) Applicants argument that Belt et al. teaches away from crosslinking the hydrogenated rubber is not persuasive. While Belt et al. does teach away from crosslinking the polymer during the hydrogenation process (1:27-30), there is nothing in the patent to teach away from post-crosslinking the hydrogenated rubber. The crosslinking prohibition only applies to "early in the hydrogenation process" and is intended to avoid the retention of the catalyst in the rubber. Following the hydrogenation process catalyst retention would no longer be an issue. Huppke et al. explicitly teaches crosslinking the rubber following the hydrogenation is ceased (1:29-42).

- C) In response to applicant's argument that Belt et al. and Sasagawa et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Belt et al. and Sasagawa et al. are analogous art as they concerned with the same field of endeavor, namely hydrogenated polyisoprenoids. Although the structures of the two polymers are not identical, a person having ordinary skill in the art at the time of invention would have expected the properties to be similar due to their similar chemical structures.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

LJH
February 5, 2009